

TTAB

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

	X	
	:	Cancellation No. 24,108
GALLEON S.A.,	:	
BACARDI-MARTINI U.S.A., INC., and	:	
BACARDI & COMPANY LIMITED,	:	
	:	
Petitioners,	:	
	:	
-against-	:	
	:	
HAVANA CLUB HOLDINGS, S.A. and	:	
HAVANA RUM & LIQUORS, S.A. d/b/a H.R.L.,	:	
S.A.,	:	
	:	
Respondents.	:	
	X	



08-21-2002

U.S. Patent & TMO/TM Mail Rpt Dt. #39

**PETITIONERS' MOTION TO RESUME
PROCEEDINGS PURSUANT TO TBMP §510.02(b)**

Petitioners, Bacardi & Company Ltd., formerly Galleon, S.A., and Bacardi U.S.A., Inc., formerly Bacardi-Martini U.S.A., Inc., (collectively hereinafter: "Bacardi"), respectfully move the Board to resume proceedings in Cancellation No. 24,108. On May 13, 2002, the Board ordered suspension of the instant proceeding pending disposition of an appeal taken by Bacardi before the United States Court of Appeals for the Federal Circuit in connection with this proceeding entitled Galleon, S.A. and Bacardi-Martini U.S.A., Inc. v. James E. Rogan, Director of the U.S. Patent and Trademark Office, No. 02-1289 (the "Federal Circuit Appeal"). By Order dated July 31, 2002, the Federal Circuit dismissed that appeal. Pursuant to the Board's May 13th Order, Bacardi filed a copy of the Federal Circuit's Order with the Board on August 8, 2002. (A copy is attached hereto as Exhibit A). Accordingly, pursuant to TBMP §510.02(b), Cancellation No. 24,108 should now be resumed and a briefing schedule should be

set concerning Bacardi's Motion to Resume Proceedings, to Substitute Parties and for Summary Judgment filed on March 15, 2002, a courtesy copy of which is being served upon Cubaexport concurrently with the instant Motion.

Dated: August 21, 2002
New York, New York

Respectfully Submitted,

KELLEY DRYE & WARREN LLP

By: Michelle M. Graham
William R. Golden, Jr.
Michelle M. Graham

101 Park Avenue
New York, New York 10178
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Attorneys for Petitioners
Bacardi & Company, Ltd. (formerly Galleon,
S.A.) and Bacardi U.S.A., Inc. (formerly
Bacardi-Martini U.S.A., Inc.)

Of Counsel:

Frederick J. Wilson, III, Esq.

NOTE: Pursuant to Fed. Cir. R. 47.6, this order
is not citable as precedent. It is a public order.

United States Court of Appeals for the Federal Circuit

02-1289

GALLEON, S.A. (now known as Bacardi & Company, Ltd.)
and BACARDI-MARTINI U.S.A., INC. (now known as Bacardi USA, Inc.),

Appellants,

v.

James E. Rogan,
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE,

Appellee.

ON MOTION

Before LOURIE, GAJARSA, and LINN, Circuit Judges.

LOURIE, Circuit Judge.

ORDER

The Director of the United States Patent and Trademark Office moves to dismiss the appeal filed by Galleon, S.A. and Bacardi-Martini U.S.A., Inc. (Bacardi) for lack of jurisdiction. Bacardi opposes. The Director replies. Additionally, parties that were initially included in this court's official caption object to their inclusion in the official caption.

This case has an unusual history. Havana Club Holding, S.A. and Havana Club, International, S.A. (Havana Club) sued Bacardi in the United States District Court for the Southern District of New York for trademark infringement. Bacardi counterclaimed for cancellation of the mark. At the same time, there was pending before the PTO a

cancellation proceeding filed by Bacardi concerning the same trademark. The PTO cancellation proceeding was stayed pending disposition of the court action.

The district court determined that alleged assignments of the trademark to Havana Club, by Empresa Cubana Exportadora De Alimentos Y Productos Varios trading as Cubaexport (Cubaexport), were invalid and void ab initio. The district court stated that "Cubaexport retained whatever rights it had in said mark and the related U.S. Registration as of said date, notwithstanding the invalid transfers." The district court denied Bacardi's request for cancellation because Cubaexport was not a party to the litigation. Havana Club Holdings, S.A. v. Galleon S.A., 974 F.Supp. 302 (S.D.N.Y. 1997). The district court informed the PTO of its determination concerning the invalidity of the assignments, pursuant to 15 U.S.C. § 1119, but stayed operation of that partial judgment pending appeal. The district court's judgment was affirmed by the United States Court of Appeals for the Second Circuit. Havana Club Holding, S.A. v. Galleon S.A., 203 F.3d 116 (2d Cir. 2000), cert. denied, 531 U.S. 918 (2000).

Thereafter, Bacardi notified the PTO that the stay, pending appeal, of the district court's judgment should be lifted. The PTO issued an order directing the parties to show cause why the records concerning the trademark should not be rectified to reflect the district court's judgment concerning the invalid assignments. After considering the parties' responses, the PTO on January 15, 2002 issued a "Notice" stating that the PTO's records would be rectified to reflect the district court's order. Bacardi filed an appeal from that notice, seeking review in this court.

Our review of decisions concerning trademarks is limited. We have jurisdiction, inter alia, to review decisions of the Trademark Trial and Appeal Board with respect to

applications for registration of marks, cancellation proceedings, and opposition proceedings. See 15 U.S.C. § 1071; 28 U.S.C. § 1295(a)(4)(B). Bacardi argues that this appeal should be treated as an appeal of a decision in a cancellation proceeding, although the cancellation proceeding initiated by Bacardi is pending. Bacardi asserts that, by issuing the order to show cause, the PTO initiated a cancellation proceeding and, essentially, denied cancellation because the PTO apparently did not rectify its records to satisfy Bacardi. We are not persuaded by this argument.

Bacardi also argues that the court could treat its appeal as a petition for writ of mandamus. However, in the papers submitted, Bacardi has shown no entitlement to a writ of mandamus. Bacardi may, of course, appeal from any adverse decision of the TTAB after the TTAB issues a final decision in Bacardi's cancellation proceeding.

Accordingly,

IT IS ORDERED THAT:

- (1) The Director's motion to dismiss is granted.
- (2) Each side shall bear its own costs.
- (3) The reformed caption is reflected above.

FILED
U.S. COURT OF APPEALS FOR
THE FEDERAL CIRCUIT

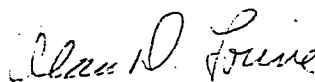
JUL 31 2002

JAN HORBALY
CLERK

FOR THE COURT

JUL 31 2002

Date



Alan D. Lourie
Circuit Judge

cc: William R. Golden, Jr. Esq.
John M. Whealan, Esq.
Charles S. Sims, Esq.

We express no opinion whether there would be jurisdiction to challenge the notice in a district court pursuant to the Administrative Procedure Act.

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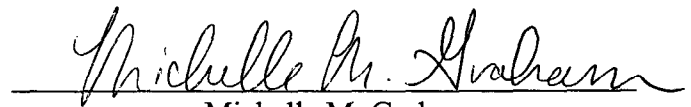
ISSUED AS A MANDATE: JUL 31 2002

CERTIFICATE OF MAILING

EXPRESS MAIL LABEL NO.: ET874003213US

DATE OF DEPOSIT: August 21, 2002

The undersigned hereby certifies that on August 21, 2002 a copy of the foregoing PETITIONERS' MOTION TO RESUME PROCEEDINGS PURSUANT TO TBMP §510.02(b) is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. 1.10 on the date indicated above and is addressed to Box TTAB-No Fee, Assistant Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513.


Michelle M. Graham

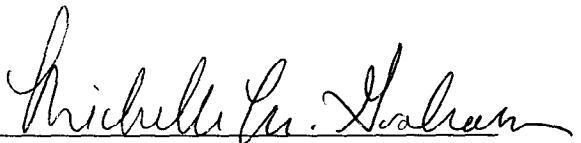
CERTIFICATE OF SERVICE

The undersigned hereby certifies that on August 21, 2002 a copy of the foregoing PETITIONERS' MOTION TO RESUME PROCEEDINGS PURSUANT TO TBMP §510.02(b) has been served upon:

(A) Charles S. Sims, Esq. of Proskauer Rose LLP by depositing a true copy thereof with Federal Express addressed to the aforesaid attorney at 1585 Broadway, New York, New York 10036, the address designated by said attorney for that purpose; and

(B) Empresa Cubana Exportadora de Alimentos y Productos Varios (Cubaexport) by depositing a true copy thereof with Global Priority Mail addressed to 55 23rd Street, Vedado Havana, Cuba. Cubaexport is also hereby served with Petitioners' MEMORANDUM OF LAW IN SUPPORT OF PETITIONERS' MOTION TO RESUME PROCEEDINGS, TO SUBSTITUTE PARTIES AND FOR SUMMARY JUDGMENT previously filed with the Board on March 15, 2002.

Dated: August 21, 2002


Michelle M. Graham

KELLEY DRYE & WARREN LLP

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August 21, 2002

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08-21-2002

U.S. Patent & TMO/TM Mail Rpt Dt. #39

Re: Galleon, S.A. et al. v. Havana Club Holdings, S.A., et al.,
Cancellation No. 24,108

Dear Sir or Madam:

In connection with the above-captioned cancellation proceeding, we enclose
PETITIONERS' MOTION TO RESUME PROCEEDINGS PURSUANT TO TBMP §
510.02(b).

Kindly acknowledge receipt of same by stamping and returning the enclosed self-
addressed postcard.

Sincerely,

Michelle M. Graham
Michelle M. Graham

Enclosures